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10/804,542	03/19/2004	Marc Ira Lipton	8285/679	7478

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Peter C. Breen  
BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, IL 60610

EXAMINER
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LINDSEY, MATTHEW S

ART UNIT	PAPER NUMBER
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4152

MAIL DATE	DELIVERY MODE
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10/24/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/804,542

Applicant(s)

LIPTON, MARC IRA

Examiner

Matthew S. Lindsey

Art Unit

4152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 30 July 2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 20-36 are pending in this application.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 29-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 29-32 fail to place the invention squarely within one statutory class of invention.

On pages 6-7, lines 19-21, 28-32 (page 6), 1-2 (page 7) of the instant specification, applicant has provided evidence that applicant intends the "medium" to include signals.

As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore these claims are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20-36 rejected under 35 U.S.C. 103(a) as being unpatentable over Ogle et al. (Patent No. US 6,430,604), hereinafter Ogle, in view of Pepe et al. (Patent No. US 5,742,905), hereinafter Pepe.

5. With respect to claim 20, Ogle doesn't disclose "a telephone call;", but discloses A method comprising: identifying a user making said telephone call (Figure 5G: object 760, Col 14, line 41); detecting an online status (Figure 5G: object 785, Col. 14, lines 45-46 "Block 780 and 785 determine if R is currently reachable by a registered IMS") of at least one member of a group associated with said user (Figure 3: object 300, Col 7, lines 57-61); and sending a message within said telephone call, said message indicating said online status of said at least one member of said group (Figure 5G: objects 790, 800, Col 14, lines 44-47, lines 52-54).

However, Pepe discloses "a telephone call;" (Col 3, lines 48-51)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the wireless messaging service providing availability information of

Art Unit: 4152

Ogle, with the teachings of Pepe to use a “network that operates as an interface between wireless and wireline networks, and also performs media translation, where necessary” (Col 3, lines 48-51), to enhance the ability of instant message service (IMS) users to detect online status by being able to request presence information on a multitude of devices, not limited to voice telephone calls or wireless messaging services.

6. With respect to claim 21, Ogle in view of Pepe disclose “The method of Claim 20,” and it is inherent “further comprising: receiving a password of said user”. It is inherent to protect the sensitive contact information stored in the registry to use and require a password from the user requesting status notification to be sure the user requesting the information has access to it.

7. With respect to claim 22, Ogle in view of Pepe disclose “The method of Claim 20,” Ogle also discloses “further comprising: determining said group of members associated with said user” (Figure 3: object 300, Col 7, lines 57-61, it is inherent that after creating a registry of users that to access information from the registry the system must determine the group of members associated with the user).

8. With respect to claim 23, Ogle in view of Pepe disclose “The method of Claim 20,” Ogle also discloses “further comprising: receiving instructions to detect an online

Art Unit: 4152

status of said at least one member of said group" (Figure 5G: object 760, Col 14, line 41).

9. With respect to claim 24, Ogle in view of Pepe disclose "The method of Claim 20," Ogle does not disclose "further comprising: wherein said message comprises an audio message".

However, Pepe discloses "further comprising: wherein said message comprises an audio message" (Col 3, lines 48-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the wireless messaging service providing availability information of Ogle, with the teachings of Pepe to use a "network that operates as an interface between wireless and wireline networks, and also performs media translation, where necessary" (Col 3, lines 48-51), to enhance the ability of instant message service (IMS) users to detect online status by being able to request presence information on a multitude of devices, not limited to wireless messaging services, and being provided an answer in a media format relative to the device being used, in this case an audio message when making a voice telephone call.

10. With respect to claim 25, Ogle doesn't disclose "a telephone call;" but discloses A method comprising: identifying a user making said telephone call (Figure 5G: object 760, Col 14, line 41); receiving instructions to detect an online status of at least a first member and a second member associated with said user (Figure 5G: object 760, Col

Art Unit: 4152

14, line 41, it is clear that Ogle intended use of the online status notification system to check more than one users status in a group associated with the requesting user, from figure 3 which lists multiple users associated with the requesting user); detecting said first member of said group is online (Figure 5G: object 785, Col 14, lines 45-46); detecting said second member of said group is off-line (Figure 5G: object 785, Col 14, line 52, it is inherent that there will be a situation when out of two users the first will be online and the second will be offline); and sending a message within said telephone call, said message indicating online status of at least said first and second member of said group (Figure 5G: objects 790, 800, Col 14, lines 45,55).

However, Pepe discloses "a telephone call;" (Col 3, lines 48-51)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the wireless messaging service providing availability information of Ogle, with the teachings of Pepe to use a "network that operates as an interface between wireless and wireline networks, and also performs media translation, where necessary" (Col 3, lines 48-51), to enhance the ability of instant message service (IMS) users to detect online status by being able to request presence information on a multitude of devices, not limited to voice telephone calls or wireless messaging services.

11. With respect to claims 26-28, these claims contain the same limitations of claims 21,22, and 24, which have been rejected to above.

Art Unit: 4152

12. With respect to claims 29-32, these claims contain the same limitations of claims 20-24, with the exception that claim 22's limitation is imported into claim 29. However all of these claims have been objected to above, changing a method for a computer readable medium does not change the limitations in such a way to overcome rejection.

13. With respect to claim 33, Ogle doesn't disclose "a telephone call from said first member," but discloses A method comprising: detecting an online status of a user (Figure 5G: object 785); determining that a first member of a group associated with the user is off-line (Figure 5G: object 785, Col 14, line 52); storing a notification message of said online status of said user in a storage device (it is inherent in Ogle to store a notification message of online status of a user in a storage device prior to sending this message to a user requesting the information); and sending a message within said telephone call, said message comprising said notification message stored in said storage device (Figure 5G: objects 790, 800, Col 14, lines 45, 55).

However, Pepe discloses "a telephone call from said first member;" (Col 3, lines 48-51)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the wireless messaging service providing availability information of Ogle, with the teachings of Pepe to use a "network that operates as an interface between wireless and wireline networks, and also performs media translation, where necessary" (Col 3, lines 48-51), to enhance the ability of instant message service (IMS) users to detect online status by being able to request presence information on a



multitude of devices, not limited to voice telephone calls or wireless messaging services.

14. With respect to claim 34, Ogle in view of Pepe disclose "The method of Claim 33," and it is inherent "further comprising: determining a user-initiated notification option is enabled". It is inherent from Ogle that by entering contact information in the registry of figure 3 a user is enabling a notification option.

15. With respect to claims 35-36, these claims contain the same limitations of claims 21, and 24, which have been rejected to above.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Wick (Patent No US 6,691,162 B1) teaches monitoring users of a computer network.
- b. Aravamundan et al. (Patent No US 6,301,609 B1) teaches differing levels of communication of members of a buddy list based on assigned priorities.
- c. Aggarwal et al. (Patent No US 6,260,148 B1) teaches a messaging system where users can subscribe to information including online status.
- d. Cuomo et al. (Patent No US\*6,148,328) teaches a messaging system where users are informed of the arrival and departure of buddies.

Art Unit: 4152

- e. Aggarwal et al. (Patent No US 5,943,478) teaches a messaging system where users receive a popup message to indicate arrival and departure of buddies.
- f. Chen et al. (Patent No US 5,751,791) teaches handling of messages when the intended recipient is unavailable.
- g. Pepe et al. (Patent No US 5,742,668) teaches providing a user remote control the receipt and delivery of wireless and wireline electronic text messages.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Lindsey whose telephone number is (571) 270-3811. The examiner can normally be reached on Mon-Thurs 7:30-5, Alternate Fridays 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on (571) 272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4152

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MSL

 JOHN FOLLANSBEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100